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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/669,416	09/25/2003	Robert Mills	46527	5060

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EXAMINER

FLOOD, MICHELE C

ART UNIT PAPER NUMBER

1655

DATE MAILED: 11/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/669,416

Applicant(s)

MILLS ET AL.

Examiner

Michele Flood

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on December 1, 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) 4-9 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>2/17/04;3/21/05</u> . | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

Applicant's election with traverse of Group I, Claims 1-3, in the reply filed on December 1, 2004 is acknowledged. The traversal is on the ground that the invention of Group III is directed to a method of using the composition of Group I; and, therefore the inventions of Group I and Group III should be maintained in the same application as claims 1, 2, and 3. This is not found persuasive because the restriction is clearly proper for all of the reasons set forth in the previous Office action.

The requirement is still deemed proper and is therefore made FINAL.

**Claims 1-3 are under examination.**

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-3 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1-3 are rendered vague and indefinite by the term "extract" because this term, in and of itself, does not adequately delineate its metes and bounds. This term is best defined as a product-by-process since product-by-process claims are intended to define products which are otherwise difficult to define (and/or distinguish from the prior art). For example, is the extract obtained via extraction with water, a polar solvent, a non-polar solvent, an acid or base, a squeezed extract, or something else? In addition,

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from what part(s) of the plant is the extract obtained? It is well accepted in the herbal art that extraction with one of various distinct solvents, as well as from particular parts of therapeutic plants, has a profound impact on the final product with respect to the presence, absence, amounts, and/or ratios of active ingredients therein and, thus, its ability to provide the desired functional effect(s) instantly claimed and/or disclosed. Since the extract itself is clearly essential to the claimed invention, the step(s) by which the claimed extract is obtained are also clearly essential and, therefore, must be recited in the claim language itself (i.e., as a product-by-process). Please note that although the claims are interpreted in light of the specification, critical limitations from the specification cannot be read into the claims (see, e.g., *In re Van Guens*, 988 F.2d 1181, 26 PSPG2d 1057 (Ded. Cir. 1991)). Accordingly, without the recitation of all these critical limitations as set forth above, the claims do not adequately define the instant invention.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1 and 2 are rejected under 35 U.S.C. 102(b) as being anticipated by Bonte et al. (A\*).

Applicant claims a skin treatment composition comprising an extract of *Mahonia aquifolium* in a liposome delivery system. Applicant further claims a skin treatment composition as claimed in claim 1 wherein the extract of *Mahonia aquifolium* is present in a concentration of from 5% to 20% by weight of the total composition.

Bonte teaches a skin treatment composition comprising 0.001% to 5% by weight based on the total weight the composition of oxyacanthine in a liposome delivery system. See patent claims 31, 32 and 36. In Column 2, line 66 to Column 3, line 11, Bonte teaches that the oxyacanthine comprising the referenced composition can be obtained from *Mahonia aquifolia* (also known in the art of botany as *Mahonia aquifolium*).

The reference anticipates the claimed subject matter.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bonte et al. (A\*) in view of Misik et al. (UA1) and Bezakova et al. (UA2).

Applicant's claimed invention of Claims 1 and 2 was set forth above. Applicant further claims a skin treatment composition as claimed in claim 1 wherein the extract of

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*Mahonia aquifolium* is present in a concentration of from 10% by weight of the total composition.

The teachings of Bonte are set forth above. Bonte does not teach a skin treatment composition comprising 10% by weight based on the total weight the composition of an extract of *Mahonia aquifolium* in a liposome delivery system. However, it would have been obvious to one of ordinary skill in the art and one of ordinary skill in the art would have been motivated and one would have had a reasonable expectation of success to adjust the instantly claimed amounts of ingredients in the composition taught by Bonte to provide the instantly claimed invention because at the time the invention was made it was known in the art that an effective amount of an extract of *Mahonia aquifolium* was useful in the making of skin treatment compositions, as evidenced by the teachings of Misik and Bezakova. Thus, it would have been merely a matter of judicious selection to one of ordinary skill in the art at the time the invention was made to modify the amounts of the ingredients used in the claimed composition because it would have been well in the purview of one of ordinary skill in the art practicing the invention to select result-effect amounts of the claimed ingredients to provide a composition with a beneficial functional effect as a skin treatment composition in a liposome delivery system. The claimed invention is no more than the routine optimization of a result effect variable.

Accordingly, the instant claims, in the range of proportions where no unexpected results are observed, would have been obvious to one of ordinary skill having the above cited references before him.

From the teachings of the references, it is apparent that one of ordinary skill in the art would have had a reasonable expectation of success in producing the claimed invention. Therefore, the invention as a whole was *prima facie* obvious to one of ordinary skill in the art at the time the invention was made, as evidenced by the references, especially in the absence of evidence to the contrary.

### ***Claim Objections***

Claim 2 is objected to because of the following informalities: With regard to Claim 2, line 3, there is an apparent misspelling. Applicant may overcome the objection by replacing "t" with to. Appropriate correction is required.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michele Flood whose telephone number is 571-272-0964. The examiner can normally be reached on 7:00 am - 3:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terry McKelvey can be reached on 571-272-0775. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



**MICHELE FLOOD**  
**PRIMARY EXAMINER**

Michele Flood  
Primary Examiner  
Art Unit 1655

MCF  
November 10, 2005